

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 74, 76, 77, 79-86, 91, 93, and 95-109 are pending in the application, with claims 74, 76, 77, 79, 83-86 and 91 being the independent claims. Claims 6-64, 68-73, 75, 78, 87-89, 90, 92, and 94 are sought to be canceled without prejudice to or disclaimer of the subject matter therein. New claims 95-109 are sought to be added. Claims 87-89 have been rewritten as new claims 95-109 to remove multiple dependency.

The specification has been amended to perfect the benefit claim to earlier applications. Support for the incorporation by reference of Application Nos. 08/589,107, 60/013,833, 08/347,610, 08/159,339, 08/103,396, and 08/027,746 can be found in the original application, at page 1, lines 2-6. This application was filed before November 29, 2000, therefore the amendment to the benefit claim is timely and 37 C.F.R. § 1.78(a)(2)(ii) does not apply. Accordingly, Applicants respectfully request entry of the amended benefit claim.

It is believed these changes introduce no new matter, and their entry is respectfully requested.

This Amendment is being filed along with a request for continued examination. Therefore, entry of the amendments is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Objection to the Oath or Declaration

The Office Action maintained the objection to the oath or declaration. In a previous Office Action (Paper 18, page 2), the Examiner stated that the oath or declaration was allegedly defective for failing to recite the priority applications. In the outstanding Office Action (Paper 36, page 2), the Examiner stated that a new oath or declaration is required that recites the application number and filing date. Applicants respectfully disagree with the objection.

Applicants assert that in accordance with 37 C.F.R. §§ 1.63 and 1.67, no claim for priority to U.S. applications is required to be set forth in an oath or declaration. The only requirement regarding prior applications is the requirement to list *foreign* priority applications. 37 C.F.R. § 1.63(c)(2). Therefore, the Declaration filed on July 17, 1998 is not defective for failure to list the prior U.S. applications. Further, the Declaration filed on July 17, 1998 did include the application number and filing date. Thus, Applicants respectfully believe that no supplemental Declaration is required.

Accordingly, reconsideration and withdrawal of the objection are respectfully requested.

Objection of Claims Under 37 C.F.R. § 1.75(c)

Claims 87 and 88 were objected to under 37 C.F.R. § 1.75(c) as allegedly being of improper form. Applicants have canceled claims 87-89 and rewritten the claims as new claims 95-109 to remove the multiple dependency from claim 80. Therefore, Applicants believe that the objection has been rendered moot. Accordingly, reconsideration and withdrawal of the objection are respectfully requested.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 80-82 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants have amended claim 80 to remove the dependency to claims that recite non-elected subject matter (claims 75 and 78). Therefore, Applicants believe that the rejection has been rendered moot. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 83-88 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in such a way as to enable one skilled in the art to make and/or use the invention. The Office Action stated that "the specification does not disclose which peptides encompassed by the instant claims could be used to diagnose which diseases and condition." (Paper 36, page 3). Applicants respectfully traverse.

First, Applicants note that one of ordinary skill in the art, in attempting to diagnose a disease, takes into consideration the symptoms and signs of the patient before ordering further diagnostic tests. For example, a patient presenting with jaundice may be tested for infection with a hepatitis virus. See *e.g. Harrison's Principles of Internal Medicine*, Petersdorf, R.G. *et al.*, eds. 10th edition, McGraw-Hill Book Company, New York, N.Y. (1983). Second, the artisan of ordinary skill testing for hepatitis infection, for example, would of course use an epitope from a hepatitis antigen rather than an epitope from another infectious agent. Whether a given hepatitis epitope would be potentially cross-reactive with epitopes from other infectious agents is easily determined using

sequence comparison programs. Thus, the artisan could easily choose a peptide comprising the recited motif that does not cross-react with cytotoxic T lymphocytes against another infectious agent. Further, the specification provides guidance by giving examples of peptides useful for diagnosing HIV, HCV, HBV, Lassa virus, and the cancer antigen CEA in Tables 9 and 10. Therefore, Applicants respectfully request that the rejection be reconsidered and withdrawn.

Claims 74, 76-77, and 79-81 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in such a way as to enable one skilled in the art to make and/or use the invention. Applicants have amended the claims to recite a "composition" rather than a "pharmaceutical composition." Therefore, Applicants believe that the rejection has been rendered moot. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Claims 74, 76-77, 79-81, and 83-88 were rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in such a way as to enable one skilled in the art to make and/or use the invention. Applicants have amended the claims to recite peptide epitopes having 8 to about 11 amino acids. Therefore, Applicants believe that the rejection has been rendered moot. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejections under 35 U.S.C. § 102

Claims 74, 76-77, 79-81, 91 and 93 were rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by WO 97/34617, published September 25, 1997. Applicants have amended the priority claim to properly claim the benefit of a chain of earlier

applications. Claims 74, 76-77, 79-81, 91 and 93 are entitled to the benefit of at least U.S. Appl. No. 60/013,833 filed March 21, 1996. Therefore, WO 97/34617 is not available as prior art against these claims. Accordingly, Applicants respectfully request that the rejection be reconsidered and withdrawn.


Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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